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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/569,485

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Toshio Ohba

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT

PAPER NUMBER

1793

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/569,485	<b>Applicant(s)</b> OHBA ET AL.	
	<b>Examiner</b> George P. Wyszomierski	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/24/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

1. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Independent claim 1 states that the inventive material is one "not containing Ni and Mo". Page 5 of the specification indicates an upper limit of 2.0% Mo and 3.0% Ni in the inventive material. As such, it is unclear what impurity level(s) of these elements can be tolerated yet remain within the scope of the instant claims.

b) Claim 2 is directed to a method, but does not recite any steps to be performed. Thus, the claim is indefinite.

c) In claims 3 and 4, the meaning of "or" in line 2 of these claims is unclear. Does the inventive method require only one of quenching or normalizing? If it requires quenching, then is the temperature of "1000.deg.C or more" the starting temperature (at the beginning of the quenching) or is this the final temperature (at completion of quenching)? For purposes of examination, the examiner will give these claims their broadest reasonable interpretation, and hold that they require only one of quenching or normalizing.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Igarashi et al. (U.S. Patent 6,299,704).

Igarashi Table 1 discloses compositions containing 8% or more Cr, and not containing Ni and Mo. These compositions have a tempered martensite structure, and are excellent in creep strength at over 650.deg.C and thus are held to meet the final clause of instant claim 1.

Igarashi column 11, lines 35-40 indicates that the compositions are manufactured by a method in accord with instant claim 3. Thus, all aspects of the claimed invention are held to be fully disclosed by Igarashi et al.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al.

Igarashi, discussed supra, does not disclose any specific example of a composition composed of the elements defined in claim 2. However, Table 1 of Igarashi discloses materials that lack molybdenum, platinum, and palladium, and that contain no more than residual amounts of additional elements such as P and S. The examiner's position is that it would have been obvious for one of skill in the art to vary the precise composition of the alloys disclosed by Igarashi to obtain a material in accord with instant claim 2. Further, with respect to claim 4, Igarashi column 11, lines 35-40 discloses a process in accord with the instant claim. Thus, a prima facie case of obviousness is established between the disclosure of Igarashi et al. and the presently claimed invention.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1275744 (Reference AN on the attached PTO-1449 form).

Table 1 of EP '744 discloses compositions in accord with instant claims 1 and 2, with the exception that the prior art compositions contain residual amounts of Mo, P, and S. According to paragraphs [0045-0046] of EP '744, the prior art materials are normalized at 1050-1100.deg.C and tempered at 750-800.deg.C, and are thus manufactured in accord with the process of instant claims 3 and 4.

As stated above, the specific compositions of the prior art contain a small amount of Mo and thus do not precisely meet the limitations of the instant claims. However, EP '744 sets no precise lower limit on the amount of Mo in the prior art compositions, but repeatedly states only an amount of "no more than 2.0%" Mo; see paragraphs [0009], [0010], and [0016] of EP '744. This both includes an amount within the limits of the composition as claimed, and is consistent with the present Applicant's characterization of the amount of Mo in the inventive compositions as disclosed on page 5 of the present specification.

Therefore, no specific or patentable distinction is seen between the materials/methods as defined in the present claims and those of the prior art, and a prima facie case of obviousness is established between the disclosure of EP 1275744 and the presently claimed invention.

7. The remainder of the art cited on the attached PTO-892 and 1449 forms is of interest. This art is held to be no more relevant to the claimed invention than the art as applied in the rejections, supra.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/George Wyszomierski/  
Primary Examiner  
Art Unit 1793

GPW  
July 28, 2008